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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,517	09/29/2006	Qiong Liu	608079-000001	1162
29858 7590 11/12/2008 THELEN REID BROWN RAYSMAN & STEINER LLP PO BOX 640640 SAN JOSE, CA 95164-0640				
EXAMINER				
DEGA, MURALI K				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/599,517

**Applicant(s)**

LIU ET AL.

**Examiner**

Murali K. Dega

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) None is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_
- Paper No(s)/Mail Date 20080124

## **DETAILED ACTION**

### ***Acknowledgements***

1. This office action is in response to the original application filed on 29 September 2006.
2. Claims 1-71 are currently pending and have been examined.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on January 24, 2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. An initialed copy of IDS Form 1449 is enclosed herewith.

### ***Claim Rejections - 35 USC § 112 - Second Paragraph***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4, 7, 14, 18, 29, 45, 53, 56 and 62 rejected as failing to define the invention in the manner required by 35 U.S.C. §112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language such as "if the step...", "if the transfer...", "if successful...". The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such

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a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-71 are rejected under 35 U.S.C. §102(b) as being anticipated by

Tadayon et al (US 7,222,104) herein after referred to as Tadayon.

8. Regarding claim 1:

9. Tadayon discloses a digital rights management system in which a digital license confers predetermined usage rights in relation to a digital content, a method of transferring (*Abstract*) the usage rights from a first content player application to a second content player application:

- Associating with the first content player application a first status indication ("*identification flag...*", C3, L 17) with respect to the digital

license for indicating whether the first player application is entitled to exercise the usage rights conferred by the license.

- Associating with the second content player application a second status indication ("*identification flag...*", C3, L 22) with respect to the digital license for indicating whether the second player application is entitled to exercise the usage rights conferred by the license.
- Transmitting a request (*Fig. 3, item 400*) for transfer of the usage rights from the second player application to the first player application.
- Setting the first status indication ("*changes the usage rights to prohibit...*", C 5, L 43) to indicate that the first player application is no longer entitled to exercise the usage rights.
- Transmitting a response transferring ("*transfer permission module...to reflect the exchange...*", C 5, L 37) the usage rights from the first player application to the second player application.
- Setting the second status indication to indicate that the second application is henceforth entitled to exercise ("*permit the use by new user...*", C 5, L 45) the usage rights, wherein the steps (c) to (f) are carried out in the stated order.

10. Regarding claims 2 and 70:

11. Tadayon discloses wherein the first content player application executes on a first player device (*Fig. 2, "user 130 has ...use content", C 4, L 65*) and the

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second content player application executes on a second player device (*Fig. 2, "user 132 has...use content", C 4, L 66*).

12. Regarding claim 3:

13. Tadayon discloses wherein prior to the step (c) of transmitting a request, the first status indication indicates that the first content player application is entitled to exercise ("*transfer permission information...*", C 3, L 16) the usage rights

14. Regarding claim 5:

15. Tadayon discloses wherein step (c) includes, after transmitting the request, setting the second status indication ("*current user flag for each of the works*", C 5, L 23) to indicate that the transfer of the usage rights has been requested

16. Regarding claim 6:

17. Tadayon discloses wherein the step (c) of transmitting the request includes transmitting a request message (*Fig. 3, item 400*) from the second content player application to the first content player application, the message including the value of the second status indication

18. Regarding claim 7:

19. Tadayon discloses further including the step (g) of determining if the transfer of rights was aborted by checking the values of the first and second status indications to establish if the second content player application has requested the usage rights and the first content player application is no longer

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entitled (*"ascertain if ... has been authorized"*, C 5, L 34) to exercise the usage rights.

20. Regarding claims 8 and 26:

21. Tadayon discloses wherein a plurality of status indications (*"The exchange involves more than two users"*, C 5, L 25) are associated with each of said first and second content player applications, corresponding with a plurality of digital licenses

22. Regarding claim 13:

23. Tadayon discloses wherein the step (e) of transmitting a response includes transmitting the digital license from the first player application to the second player application (*Fig. 1, item 130 and 132, "exchange can be effected..."*, C 5, L 7)

24. Regarding claims 15 and 44:

25. Tadayon discloses a digital rights management system in which a digital license confers predetermined usage rights in relation to a digital content, a system for transferring the usage rights from a first content player application to a second content player application, including: request transmitting means adapted to transmit a request for transfer of the usage rights from the second player application to the first player application (*Fig. 3, item 400*); first indication setting means adapted to set a first status indication associated with said first content player application to indicate that the first player application is no longer entitled to exercise the usage rights (*"changes the usage rights to prohibit..."*, C 5, L 43); response transmitting means adapted to transmit a response transferring the

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usage rights from the first player application to the second player application (*"transfer permission module...to reflect the exchange..."*, C 5, L 37); and second indication setting means adapted to set a second status indication associated with said second content player application to indicate that the second application is henceforth entitled to exercise the usage rights (*"permit the use by new user..."*, C 5, L 45).

26. Regarding claims 16, 17, 28 and 71:

27. Tadayon discloses first and second content player devices, wherein the first device includes said first indication setting means and said response transmitting means, and the second device includes said request transmitting means and said second indication setting means (*Fig. 2, item 252 and Fig. 3, items, 400, 404 and 406*).

28. Regarding claim 19:

29. Tadayon discloses wherein the request transmitting means is adapted to transmit a request message that includes the value of the second status indicator (*Fig. 1 and 3, items 400 and 404*).

30. Regarding claim 23:

31. Tadayon discloses including secure storage for storing the value of the secret key (*"a trusted system...secure storage"* C 2, L 40)

32. Regarding claims 25 and 51:

33. Tadayon discloses further including first and second tracking files associated respectively with said first and second content player applications, wherein the first and second status indications (*"setting the current user*



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*identification flag", C 3, L 19)* are implemented as transaction flags stored in said tracking files

34. Regarding claim 27:

35. Tadayon discloses at least in part, using one or more tamper resistant secure computing devices (*"general purpose computer, e.g., server", C 4, L 50*).

36. Claims 30-43 are cancelled.

37. Claims 48-49 are cancelled.

38. Claim 52 is cancelled

39. Regarding claims 54 and 63:

40. Tadayon discloses further including the step of verifying that the validated portion of the first digital license has not been altered or falsified, wherein the validated portion of the first digital license is preferably validated (*"transfer module checks transfer permission..."*, C 5, L 33) with a digital signature of a trusted authority, and the step of verifying that the validated portion of the first digital license has not been altered or falsified includes verifying that the digital signature is correct with respect to the trusted authority and the contents of the validated portion of the license.

41. Claim 55 is cancelled.

42. Regarding claim 56:

43. Tadayon discloses further including the step of rejecting the digital license if the license has been altered or falsified (*"send any appropriate notices, such as terminating notice.."*, C 6, L 12).

44. Claims 61, 64, 65, 67-69 are cancelled.

***Claim Rejections - 35 USC § 103***

45. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

46. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

47. Claims 4, 9-12, 14, 18, 20-22, 24, 29, 45-47, 50, 53, 57, 58, 59, 62 and 66 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tadayon, in view of Stefik et al (US 5,638,443).

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48. Regarding claims 4, 18 and 45:

49. Tadayon discloses wherein if the step (e) of transmitting a response is not successfully completed within a predetermined time following the completion of the step (c) of transmitting a request, the transfer of usage rights is aborted. However, Stefik teaches usage denial in the event of a timeout (*"requests go unanswered after a predetermined period of time"*, C 2, L 15).

50. Regarding claims 9 - 12, 20 - 22, 24, 46, 47 and 50:

51. Tadayon discloses further including the step (h) of computing an authentication code that is a function of the values of the respective status indicators associated with each of the first and second content player applications (*"private key corresponding to the user..."*, C 4, L 10) each time a status indication associated with the corresponding content player applications is altered. However, Stefik exhaustively teaches authentication process and computing check code using certificate key and 1-way hash functions (C 42, L 26 and C 43 L 1).

52. Regarding claims 14, 29, 53, 57-59, 62 and 66:

53. Tadayon discloses encrypting the content with a public key and then encrypting the public key with a private key corresponding to the user (C 4, L 9). However, Tadayon does not explicitly disclose computing authentication code and decrypting of the encrypted content. However, Stefik exhaustively teaches the encryption and decryption process as part of license sharing system (C 42, L 26 and C 43 L 1).

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54. Therefore, it would have been obvious to the person having ordinary skill in the art at the time of invention to combine Tadayon and Stefik, to provide a similar arrangement of authentication process to facilitate rights transfer between users, to maintain secure sharing between the users and ensure authenticity of the transaction, with neither undue experimentation nor risk of unexpected results.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Murali K. Dega whose telephone number is (571)270-5394. The examiner can normally be reached on Monday to Thursday 7.30 to 4.00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571)272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. K. D./

Examiner, Art Unit 3621

/ANDREW J. FISCHER/

Supervisory Patent Examiner, Art Unit 3621